



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,755	05/09/2001	Ethan Spiegel	081862P232D	5622

7590 11/30/2004
Stephen T. Neal
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

EXAMINER

DUONG, FRANK

ART UNIT	PAPER NUMBER
----------	--------------

2666

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/852,755

Applicant(s)

SPIEGEL ET AL.

Examiner

Frank Duong

Art Unit

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-32 is/are allowed.
- 6) ☒ Claim(s) 33-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/21&8/28/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is a response to the Preliminary Amendment dated 05/09/01.

Claims 11-43 are pending in the application.

Information Disclosure Statement

2. The information disclosure statements filed 07/21/04, 08/28/01 comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. They have been considered and placed in the application file.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "**A device, comprising: an asynchronous transfer mode (ATM) communications component to communicate on an ATM network; a memory storage component to store an ATM address, which includes a private network-network interface IPNNII peer group identification based on a manufacturer of the device and a product group to which the device belongs, to facilitate communication on the ATM network; an interface to allow the manufacturer of the device to input the ATM address into the memory storage component at a point of manufacture automatically**" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

Art Unit: 2666

replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. Applicant is reminded of the following requirement:

In a continuation or divisional application (other than a continued prosecution application filed under 37 CFR 1.53(d)), the first sentence of the specification or application data sheet (37 CFR 1.76) should include a reference to the prior application(s) from which benefit of priority is claimed. See 37 CFR 1.78. The following format is suggested: "This is a continuation (or divisional) of Application No._____, filed_____, now (abandoned, pending or U.S. Patent No._____)".

Art Unit: 2666

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: *"A device, comprising: an asynchronous transfer mode (ATM) communications component to communicate on an ATM network; a memory storage component to store an ATM address, which includes a private network-network interface IPNNII peer group identification based on a manufacturer of the device and a product group to which the device belongs, to facilitate communication on the ATM network; an interface to allow the manufacturer of the device to input the ATM address into the memory storage component at a point of manufacture automatically. "*

Claim Objections

6. Claims 22 and 34-43 are objected to because of the following informalities:

As per claim 22, line 2, "the machine" should read --a machine--.

As per claims 34-43, line 1, "The system" should read --The device--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 33-43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply

Art Unit: 2666

with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding **claim 33**, there is no support for the claimed limitation of “a device, comprising: an asynchronous transfer mode (ATM) communications component to communicate on an ATM network; a memory storage component to store an ATM address, which includes a private network-network interface PNNI peer group identification based on a manufacturer of the device and a product group to which the device belongs, to facilitate communication on the ATM network; an interface to allow the manufacturer of the device to input the ATM address into the memory storage component at a point of manufacture automatically”, recited in claim 33, in the specification. In accordance with the specification, on pages 5-9, in reference to FIG. 1, it is disclosed an autoconfigured ATM address 100 comprises a 20-byte ATM address value including AFI, manufacturer ID, manufacturer specific, switch ID and device ID fields. The specification does not disclose a device comprising an ATM communications component; a memory storage; and an interface in a manner set forth as recited in claim 33. From the disclosed features, the claimed limitation “a device, comprising: an asynchronous transfer mode (ATM) communications component to communicate on an ATM network; a memory storage component to store an ATM address, which includes a private network-network interface PNNI peer group identification based on a manufacturer of the device and a product group to which the

Art Unit: 2666

device belongs, to facilitate communication on the ATM network; an interface to allow the manufacturer of the device to input the ATM address into the memory storage component at a point of manufacture automatically" cannot unambiguously derive to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 34-43 fall with their parent claim 33.

This application is a divisional application of parent application 08/876,952. A careful review the specification of the parent application, Examiner also fails to find description for the claimed invention of claims 33-43. In a response to this Office Action, Applicants should cancel claims 33-43 because while a divisional application may depart from the phraseology used in the parent application there may be no departure therefrom in substance or variation in the disclosure that would amount to "new matter" if introduced by amendment into the parent application.

(note: Due to the problem discussed above, there is no art applied to claims 33-43 at this time).

Allowable Subject Matter

8. Claims 11-32 are allowed.

9. The following is a statement of reasons for the indication of allowable subject matter: Sathaye et al (USP 5,517,617) as applied in the rejection of claimed invention of parent case 08/876,952 of the instant application, appears to be the closest prior. However, Sathaye patent, considered individually or in combination, fails to fairly show or suggest

Art Unit: 2666

the claimed inventions of base claims 11 and 22 comprising a novel and unobvious limitation of "*assigning a private network-network interface (PNNI) peer group identification to a device to be coupled with an asynchronous transfer mode (ATM) network based on a manufacturer of the device and a product group to which the device belongs*" structurally and functionally interconnected with other limitations in a manner set forth in claims 11 and 22. Dependent claims 12-21 and 23-32 further limit the indicated allowable base claims 11 and 22, respectively.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sathaye et al (USP 5,517,617).

Alles, ATM Internetworking, Cisco System Inc, pages 1-58, 1995.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Duong whose telephone number is (571) 272-3164. The examiner can normally be reached on 7:00AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on (571) 272-3174. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2666

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Frank Duong', with a stylized flourish at the end.

Frank Duong
Examiner
Art Unit 2666

November 18, 2004